



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/533,381	03/22/00	FANTO	N 2801-14

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HM12/0816

EXAMINER

BARTS,S

ART UNIT	PAPER NUMBER
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1621

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DATE MAILED: 08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/533,381

Applicant(s)
Fanto et al

Examiner
SAMUEL BARTS

Group Art Unit
1621



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, and 4-7 is/are rejected.

☒ Claim(s) 3 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Allowable Subject Matter

1. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 refers to formula I or II which are shown, for example, in claim 1. However, claim 4 does not expressly depend on claim 1. It is therefore indefinite since it is unclear as to what is meant by formula I or II. Each claim must stand on its own. Applicant can overcome this rejection by amending claim 4 to depend on claim 1.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1, and 4-7 ~~100~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Chem.

Abstracts 110101q.

Claim 1 is clearly anticipated because this reference discloses the claimed compound wherein $R=R_1=R_2=O-CH_3$. Claims 4-7, drawn to compositions, are also anticipated because the compound in the prior art is also a pharmaceutical and nothing of record suggest that different carriers are NEEDED for the particular recited diseases in the instant claims.

Claim Rejections - 35 USC § 103

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chem. Abstracts 110101q.


The instant claimed invention is substantially disclosed. The prior art is silent as to the use of a salt for its administration as a pharmaceutical. However, the use of salts of active compounds in the pharmaceutical art is extremely well known. It is a main mode of modifying a compound to make it more suitable to deliver to a patient. Therefore, it would have been obvious to one having

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ordinary skill in the art at the time that applicants' invention was made to have modified the compound of the prior art to make a salt.

A skilled artisan would be motivated to perform such a change in order to make the compound in the most suitable form for administering the drug.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Samuel Barts whose telephone number is (703)308-4630. The Examiner's normal tour of duty is between 6:30-3:00, M-F. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-1235. Communications may now be transmitted via FAX directly to group 1600. The official group 1200 FAX machine number is (703) 308-4556.


SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1600

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August 12, 2000
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